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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/686,197

10/10/2000

Carl C. Kah III

P/3426-7 RE

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EXAMINER

HWU, DAVIS D

ART UNIT

PAPER NUMBER

3752

MAIL DATE

DELIVERY MODE

01/13/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/686,197	<b>Applicant(s)</b> KAH, CARL C.	
	<b>Examiner</b> Davis Hwu	<b>Art Unit</b> 3752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,4-28,30 and 31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16-19 and 21 is/are allowed.
- 6) ☒ Claim(s) 1,4-15,20,22-28,30 and 31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |



***Response to Amendment***

1. Applicant's response of November 24, 2008 have been entered and fully considered.
2. The Reexamination Certificate and Supplemental Declaration are acknowledged and have been placed of record.
3. The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.
4. Claims 1, 4-15, 20, and 22-28 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

During the prosecution of application 08/405033 (Patent 5,826,797) an amendment was filed August 8, 1996 adding the following limitation to independent claim 1 and including such limitation in independent claim 12: "sealing means surrounding the discharge end of a water passage formed in said nozzle housing; said sealing means including a seal member..." According to Applicant's

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arguments accompanying this amendment, this change occurred to more specifically define the seal of the instant invention from the prior art. Since this limitation was added in response to a rejection of the claims, the removal of such limitation is considered to be recapture.

During the prosecution of application 08/405033 (Patent 5,826,797) an amendment was filed January 15, 1997 adding the following limitation to independent claim 1: "means for retaining said nozzle selection sleeve in place". The next action was a Notice of Allowability. Since this limitation was added in response to a rejection of the claims, the removal of such limitation is considered to be recapture even though that limitation is not specifically mentioned by Applicant or the examiner.

During the prosecution of application 08/405033 (Patent 5,826,797) an amendment was filed August 8, 1996, that added new claims 23-26 that were said to be limited to the combination of the nozzle housing and riser where the nozzle selection is mounted to surround the nozzle housing to rotate therewith and relative thereto. Such combination was deemed to make the claims allowable. New claims 22-30 in this reissue application are deemed to be broader than patented claims 16-19 (which relate to the claims that were numbered 23-26 during the prosecution of application 08/405033) because they do not call for the nozzle selection to surround the nozzle housing and riser. Since this limitation was added in response to a rejection of the claims and deemed to be allowable, the removal of such limitation is considered to be recapture.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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6. Claims 30 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Kah, Jr.

Kay, Jr. shows a sprinkler comprising a riser assembly a rotatable nozzle housing having a flow passage formed therein a drive shaft 104 as recited, and a nozzle plate 196 including an orifice as recited.

***Allowable Subject Matter***

7. Claims 16-19 and 21 are allowed.

***Conclusion***

8. Applicant's arguments filed May 24, 2002, have been fully considered but they are not persuasive. As Applicant points out, the statement is contained in the Remarks section of the August 8, 1996, amendment in parent application "the claims have been amended to more definitely define this element (the seal) which clearly distinguishes over Ballister". Thus, it was admitted on the record that the claim language was specifically changed to amend around d the art of record. Such a change points to the inclusion of broader language at this time being recapture. Applicant points out in the Remarks of this reconsideration on page 4, last paragraph, that the "unnecessarily limiting means plus function" language is merely being removed. That statement itself points to a broadening of the claim language. As for claims 22-30, these claims are indeed deemed to be broader in scope than patent claims 16-19 to which they correspond. Patented claims 16-19 were specifically presented in parent application 08/405033 as claims 23-26 in response to the fact that the prior art did not show a combination of the nozzle housing and riser where the nozzle selection is mounted to

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surround the nozzle housing to rotate therewith and relative thereto. In view of the lack of showing by the prior art, such limitations were deemed allowable. To now attempt to remove the limitation that the nozzle selection surround the nozzle housing and riser is an attempt at recapture. A recapture occurs when certain limitations that were added in a previous amendment to overcome a rejection are subsequently removed in a reissue application to broaden the claim as in this case.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Davis D. Hwu whose telephone number is 571-272-4904. The examiner can normally be reached on 8:00-4:30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Len Tran can be reached on 571-272-1184. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

/Davis D Hwu/  
Primary Examiner, Art Unit 3752